

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 2-7 are pending in the application, with claims 2, 3, and 7 being the independent claims. Claims 2-7 have been amended. These changes are believed to introduce no new matter. Further, the Examiner is respectfully requested to enter the above amendments because they place the application in condition of allowance, or in the alternative, because the above amendments place the application in better condition for appeal. Based on the above amendments and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 2-7 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,283,761, to Joao (hereinafter "the '761 patent"). Applicant respectfully disagrees with the Examiner's position that each and every feature of claims 2-7 are disclosed in the '761 patent. Therefore, based on the above amendments and following remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 2-7 under 35 U.S.C. § 102(e).

With regard to claim 2, the claim has been amended to include the feature of "providing a patient with a personal memory card (PMC) having a stored memory, wherein said stored memory includes at least ... a preferred pharmacy"

First, Applicant respectfully disagrees with the Examiner's position that the listed information claimed as stored on the stored memory discloses an intended use of the

system and therefore fails to further limit the claimed system. Contrary to the Examiner's position, the information claimed as stored on the stored memory is intended to be limiting and is in fact the very crux of the invention. The Applicant has developed an improved method of transferring and managing specific information via a personal memory card (PMC). More specifically, the Applicant has developed an improved method of preparing and fulfilling a medication prescription using a PMC. The listed information is an important part of the method claimed. Further, while the Applicant holds that the listed information is in fact a structural limitation to the PMC, as will be discussed below, the Applicant respectfully reminds the Examiner that as a method claim, even the intended use of the PMC is a further limitation to the claim 2.

The '761 patent does not disclose a memory card having a stored memory including a patient's preferred pharmacy. While the '761 patent does mention that a patient can be provided with an identification card including "any other information *described herein* as being pertinent to the respective patient, user, provider, payer, and/or intermediary," the '761 patent fails to disclose that such "pertinent" information includes the patient's preferred pharmacy. (emphasis added) (See the '761 patent, col. 39, ln 54-67, and col. 40, lns. 1-12.) As a matter of fact, the word "pharmacy" does not even appear in the '761 patent. The '761 only broadly implies that the disclosure "provides an apparatus and a method for providing a comprehensive processing system which incorporates data and/or information from any combination and/or all of the participants in the healthcare field including, but not limited to ... pharmacists . . ." (See the '761 patent, col. 12, lns. 22-42.) To say that these two broad, blanket statements anticipate a PMC including information of a patient's preferred pharmacy is to contradict the

jurisprudence of § 102, which requires that the applied reference teach each and every limitation of the claim.

Further, claim 2 recites the steps of:

- F. transmitting a prescription fulfillment request electronically by said host server for the new medication prescription contained within said updated stored memory to the preferred pharmacy, said host server configured for electronically transmitting said request; and
- G. receiving a confirmation electronically from the preferred pharmacy advising that the new medication prescription has been fulfilled.

Nowhere in the '761 patent is there any mention of transmitting a prescription fulfillment request electronically to a preferred pharmacy, and receiving a confirmation electronically advising that the prescription has been fulfilled. As stated above, if a reference does not teach each and every feature of the claim, the reference cannot anticipate the claim. As such, since the '761 patent does not teach or suggest each and every feature of claim 2, the claim should be allowable over the '761 patent. Claim 5 depends from and adds further features to claim 2. Claim 5 should be allowable for at least the same reasons as discussed above with respect to claim 2.

With regard to claim 3, the Applicant wishes to reiterate its position that the information stored on the PMC is intended to be a further limitation on the claim. To strengthen the Applicant's position, claim 3 has been amended to positively recite "data stored on the stored memory, said data including the patient's personal information, consulting physician information, and a preferred pharmacy information." As such, claim 3 has been amended to structurally define the PMC as having a stored memory which includes the listed information. Would the Examiner take the position that a claim

calling for "a pen comprising a tube including ink" is anticipated by a tube because "including ink" is only an intended use for a tube?

The '761 patent does not disclose data, stored on a stored memory of a memory card, wherein said data includes a patient's preferred pharmacy information. As stated above, while the '761 patent does mention that a patient can be provided with an identification card including "any other information *described herein* as being pertinent to the respective patient, user, provider, payer, and/or intermediary," the '761 patent fails to disclose that such "pertinent" information includes the patient's preferred pharmacy. (emphasis added) (See the '761 patent, col. 39, ln 54-67, and col. 40, lns. 1-12.) The word "pharmacy" does not even appear in the '761 patent. The '761 only broadly implies that the disclosure "provides an apparatus and a method for providing a comprehensive processing system which incorporates data and/or information from any combination and/or all of the participants in the healthcare field including, but not limited to ... pharmacists ..." (See the '761 patent, col. 12, lns. 22-42.) To say that these two broad, blanket statements anticipates "data stored on the stored memory, said data including ... a preferred pharmacy," is to contradict the jurisprudence of § 102, which requires that the applied reference teach each and every limitation of the claim.

Further, claim 3 calls for a host server "programmed to ... transmit a prescription fulfillment request for the new medication prescription to the preferred pharmacy." Nowhere in the '761 is there any mention of a host server so programmed. It should be noted that the programming of the server is not an intended use of the server. The claim does not call for "a server *for* transmitting" To the contrary, claim 3 calls for a very specific server, that being one "*programmed to ... transmit a prescription fulfillment*

request" As stated above, if a reference does not teach each and every feature of the claim, the reference cannot anticipate the claim. As such, since the '761 patent does not teach or suggest each and every feature of claim 3, the claim should be allowable over the '761 patent. Claim 6 depends from and adds further features to claim 3. Claim 6 should be allowable for at least the same reasons as discussed above with respect to claim 3.

Similarly, claim 7 has been amended to call for the feature of "data including the patient's personal information, consulting physician information, and preferred pharmacy, wherein said data is stored on the PMC." Nowhere in the '761 patent is there any teaching of data including the patient's preferred pharmacy. Further, claim 7 calls for the feature of a "server programmed ... to electrically transmit a prescription fulfillment request." Such a server is not taught by the '761 patent. Since the '761 patent does not teach or suggest each and every feature of claim 7, the claim should be allowable over the '761 patent. Claim 4 depends from and adds further features to claim 7. Claim 4 should be allowable for at least the same reasons as discussed above with respect to claim 7.

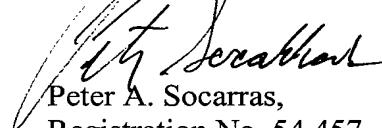
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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SKGF_593021.1

Atty. Dkt. No. 2497.0020000